



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: John D. SCHELLENBERG Confirmation No.: 2922

Application Serial No.: 08/756,257

Filed: November 25, 1996

Title: TOOL POSITION INDICATOR

Group Art Unit: 3737

Examiner: Ruth S. Smith

Docket No.: 4204.7-1

Mail Stop: AF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal.

The review is requested for the reason that the final rejection contains at least the following clear errors.

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REMARKS

I. Motivation given for modifying Manwaring et al. (5,638,819) is insufficient to establish a prima facie case of obviousness

The examiner states that “Wilk et al disclose a surgical tool having a display on the tool. It would have been obvious to one skilled in the art to have modified Manwaring et al. such that the display is mounted on the tool in order to provide a more compact system.”

First, there is no suggestion in any of the references of compactness having any advantages for this type system, and the examiner has not presented any evidence in support of this.

Second, associating a display with a tool, rather than having it separate from the tool, does not necessarily result in a more compact “system.” Putting a large display on the tool does not make the system more compact. Indeed, applicant cannot find anything to suggest that the display 24 in Manwaring et al. isn’t actually very small, in which case shifting it to the tool would not result in any compactness.

Third, at most importantly, the stated motivation is too general and does not specifically address why this particular modification would have been obvious. It is submitted that there are other ways to make the Manwaring et al. system more “compact.” For example, the surgeon could wear a “heads up” display, or the display could be projected onto a wall or other surface, or a holographic display could be used. Furthermore, the “system” could be made more compact by integrating the other components in the system with the surgical tool, leaving the display mounted elsewhere.

In sum, it is submitted that the alleged motivation does not suggest modifying Manwaring et al. in the manner suggested, and therefore the rejection of claims 22 and 42-47 is in error for at least this reason.

II. Cited references fail to teach the limitations of claims 46 and 47

The examiner states that, “With respect to claims 46, 47, it appears that the indicated direction that the tool must be moved is relative to a reference frame of the tool.” (emphasis supplied). The examiner is plainly unsure that Manwaring et al. teach this limitation. No cite to

any passage in Manwaring et al. is given. This is tantamount to having no evidence for this limitation and does not establish a *prima facie* rejection. Furthermore, it is submitted that Manwaring et al. do not, in fact, teach this limitation and therefore the alleged combination fails to meet each and every limitation of claims 46 and 47. The rejection of these claims is in error for at least this reason.

CONCLUSION

For at least these reasons the final rejection of claims 22 and 42-47 is in clearly in error and should be withdrawn.

By addressing these particular errors, Applicant is not waiving any other grounds of error, or limiting these grounds of error to the reasoning expressed. It reserves the right to address all grounds of error in on appeal, before the Board, without prejudice.

The Commissioner is hereby authorized to charge any fees that may otherwise be due with this Response to Deposit Account No. 13-4900 of Munsch Hardt Kopf & Harr, P.C.

Respectfully submitted,

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